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Re: Application No. 10/031,890 - Respond to examiner answer to appeal brief

Dear Sir/Madam,

I answer here some of the points that were raised by the examiner in his answer to my appeal brief. This answer was sent to me on Nov 12, 2004.

(a) Rejection under 35 U.S.C. 102(b)

(a.1) I have answered in the appeal brief, section (b), the objection that the second part of Claim 3 is "intended use" or "intention to employ".

(a.2) In his answer, the examiner state in the top of page 7:

Title 35 U.S.C. 102 lists the statutory categories of invention that patents may be obtained therefor. Respectfully, "behaviour of an invention" does not appear in the statute.

(a.3) However, the behaviour of the *board* is new and useful improvement of existing boards, and is therefore clearly within the limits of 35 U.S.C. 101, which explicitly includes "... any new and useful improvement thereof, ...". Thus the behaviour of the board is clearly patentable according to 35 U.S.C. 101.

(a.4) The examiner then goes on to try to match features of my Claim 3 with features in Blumberg *et al*. The matches of the board itself on p.7 are not interesting, because this is not the novelty of Claim 3. On pp. 8-9 the examiner tries to match the behaviour with features in Blumberg *et al*, but his matches are simply spurious.

(a.5) He first matches the concept of "current player's colour" with something in Blumberg *et al* (p. 8). However, in Claim 3 the point of the "current player's colour" is that it affects what happens when a point is touched, because it affects what colour unilluminated points become (and in Claim 4 it also affects which pattern is used for which colour). Thus the behaviour of the board when a point is touched is different when the current player's colour is different. In Blumberg *et al* the behaviour is always the same, and indeed in Blumberg *et al* the concept of current player's colour is meaningless, as there is only one colour.

(a.6) Then the examiner tries to match the transitions in Claim 3 to the transitions in Blumberg *et al* (bottom of p.8 and top of p.9). However, in claim 3 there are 3 different transitions (unilluminated to current colour, current colour to other colour, other colour to current colour). In Blumberg *et al* there are only two transition (ON to OFF and OFF to ON), so obviously there is no way to match the transitions. The examiner tries to perform this logical impossibility by language tricks.

(a.7) Then the examiner matches the end of the games in Claim 3 and Blumberg *et al* (p.9, middle). However, in Claim 3 when the board is all illuminated the board declares as winner the colour of the majority of the points. This idea does not appear in Blumberg *et al*, and indeed is completely inapplicable to Blumberg *et al*.

(a.8) Thus there is nothing in Blumberg *et al* that anticipates the behaviour of Claim 3, or at least the examiner couldn't find anything.

(a.9) Note that the missing points in (a.5) and (a.7) above are not minor points: they make the different between a hand-held that can be played only by one player at a time and board that can be played by two players against each other in turns. See also section (b) of my response to the non-final rejection (titled: "Re: Application No. 10/031,890 - request for reconsideration") for a lengthy discussion of the novelty and non-obviousness of Claim 3.

(b) Rejection of Claim 4 under 35 U.S.C. 112

(b.1) I have explained where in the specification there is a description matching Claim 4 in section (8.a) of the appeal brief and in paragraph (a.4) of the response to the non-final rejection.

(b.2) The examiner claims in the bottom of p.5 and top of p.6 to scan the specification and not find parts of Claim 4. He gives for example "45 degrees diagonal line become illuminated". However, the specification mentions 'X' shape in the bottom of p. 7, and mentions there that it is illustrated by the pattern around point 16 in fig. 4. From fig. 4 it is absolutely clear that the 'X' shape means 45 degrees lines (emanating from the point), and even non-expert would understand it. (Note also that in Claim 4, what is becoming illuminated are the points on the line, rather than the line itself as implied by the fragment that the examiner quotes).

(b.3) Thus the example that the examiner gives is of an element that does appear in the description, albeit in different words. That is true for all the other elements in Claim 4. As I have explained in paragraph (a.4) of the response to the non-final rejection, the claim is written to avoid the special terminology in the specification and avoiding a need to reference the drawing, but matches exactly the default settings as described on p. 8 of the specification.

(b.4) I explain in paragraph (a.3) of the appeal brief why an expert reading the specification will figure out the behaviour that is described in Claim 4 in few minutes. The Examiner mis-interpret what I wrote there as experimentation with the actual board. What I meant is that an expert trying to understand the example board from *reading the specification* will understand the default behaviour as identical to what is described in Claim 4. The experiment that I suggest in the end of paragraph (a.2) in the brief is to test this statement, i.e. let an expert read the specification and when they finish, check if they understood the default behaviour as equivalent to what is described in Claim 4. This experiment will take only few minutes, and will prove the point.

Thanks,

Yehouda Harpaz